

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 1-17 are pending in the application.

Responsive to issues raised in the examiner's Action, claims 11 and 17 have been amended in order to attend to the issues raised in item 1 of the Official Action.

In addition, the Abstract has been revised to remove mention of "present invention" and otherwise adjust it to current requirements.

The balance of the Official Action relates to three prior art-based rejections, items 3-5, all featuring an English translation of a Japanese patent document in the name of Muramoto et al.

In item 3 of the Action, claims 1-6, 9, 10, and 14-17 are rejected under 35 USC §102(b) as being anticipated by Muramoto et al. This rejection is erroneous as the reference fails to identically disclose the invention as claimed.

To anticipate a claim, a single reference must disclose the claimed invention with sufficient clarity to prove its existence in the prior art. *Motorola Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Every element of the challenged claim must be disclosed within this single reference. *PPG Industries Inc. v. Guardian Industries Corp.*, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996).

There is no anticipation because Muramoto et al state in paragraph (0008) that "in this invention, a monosaccharide and amino acid are added to a coffee extract. As for a monosaccharide glucose, xylose, etc. are mentioned. Moreover, as for amino acid, a glycine, an alanine, a leucine, an isoleucine, a valine, etc. are mentioned as amino acid. ...". In the working examples of Muramoto et al, the only amino acids tested are glycine, alanine, leucine, isoleucine and valine as shown in Tables 1, 6 and 7 of Muramoto et al. The glycine, alanin, leucine, isoleucine and valine used in Muramoto et al are not basic amino acids as used in the present invention. The term "**Basic** amino acid" is defined in applicants' specification at page 10, lines 9-15 and 21-27.

Nor does this reference have the same objective as that of the present invention. The English abstract of JP411009190A (Muramoto et al) states that the problem to be solved is "to produce the subject beverage without any deterioration in flavor and taste even in a heated state for a long period by adding a monosaccharide and an amino acid to a coffee extract solution containing a saccharide ...". Therefore, Muramoto et al use an amino acid to avoid deterioration in flavor and taste of milk-containing coffee beverage in a heated state. In contrast, in the present invention, a basic amino acid is used to avoid precipitation that occurs after heat sterilization of the milk-added coffee beverage.

As explained above, Muramoto et al differ from the present invention both in terms of the type of amino acids and the purpose of adding an amino acid in milk-added or milk-containing coffee beverage. Therefore, Muramoto et al do not anticipate the invention of claims 1-6, 9, 10 and 14-17 of the present application.

The rejection in item 5 of the Action against claims 12 and 13 under 35 USC §103(a) is traversed as claims 12 and 13 depend on patentable claim 1.

Claims 7 and 8 are rejected under 35 USC §103(a) as being unpatentable over Muramoto et al taken together with Buchheim et al. As discussed above, Muramoto et al do not disclose or even remotely suggest the prevention, of the present invention, of precipitation that occurs after heat sterilization of milk-added coffee beverage.

On closer examination it will be noted that Buchheim et al do not use a strongly basic substance such as those used in the present invention. Buchheim et al mention as preferred stabilizing salts NaHCO_3 , KHCO_3 , Na citrate, K citrate, CaCl_2 and orthophosphates (i.e., H_3PO_4), diphosphates, triphosphates and polyphosphates. See the English abstract of Buchheim, copy attached. Apparently they are weakly basic or neutral salts. In contrast, the strongly basic substance of the present invention is defined in page 9, second paragraph of the specification. Especially, it is stated that "As strongly basic substances there may be mentioned sodium hydroxide, sodium hydroxide solution, potassium hydroxide, potassium hydroxide solution, trisodium phosphate, tripotassium phosphate and the like" (page 9, lines 13-15).

In this connection, in accordance with Buchheim's disclosure the addition of stabilizing salts effects stabilization of liquid long-life milk products, meaning that Buchheim et al aim at stabilizing milk-based products whereas the present invention aims at preventing coagulation and precipitation after heat sterilization in the preparation of milk-added coffee. The two inventions are directed to solving different problems.

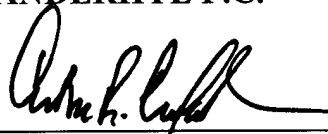
Accordingly, there is no teaching or suggestion to combine Muramoto et al and Buchheim et al. Even if the two references are combined (assuming *arguendo* it is appropriate to do so), the combination does not give rise to the present invention since the problem solved by Muramoto et al differs from that of the present invention and the salts used by Buchheim et al are not strongly basic as required by the present invention. The rejection is incorrect and should be withdrawn.

For the above reasons it is respectfully submitted that the claims of this application define inventive subject matter. Reconsideration and allowance are solicited.

Respectfully submitted,

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ABSTRACT OF THE DISCLOSURE

An economical process for producing a milk-added coffee beverage with an enhanced flavor in a process for producing a milk-added coffee beverage produced through a step of heat sterilization of coffee and milk as the main raw materials. The process includes adding a strongly basic substance and/or basic amino acid to the coffee component and conducting the heat sterilization after the milk component is admixed to the coffee component. Coagulation at the step of admixing milk component is prevented and precipitation which tends to arise after the heat sterilization is prevented with the use of a much smaller amount of emulsifier and thickening agent.